

FISH & NEAVE

875 THIRD AVENUE
NEW YORK, N.Y. 10022-6250

TELEPHONE: (212) 715-0600

TELEX: 14-8367

CABLE ADDRESS: FISHNEAVE

TELECOPIER: (212) 715-0674

CHARLES B. SMITH
DONALD E. DEGLING
DAVID W. PLANT
ALBERT E. FEY
JOHN O. TRAMONTINE
HERBERT F. SCHWARTZ
LARS I. KULLESEID
WILLIAM J. GILBRETH
ERIC C. WOGLUM
JOHN E. NATHAN
ROBERT C. MORGAN
KENNETH B. HERMAN
EDWARD F. MULLOWNEY

ROBERT R. JACKSON
JESSE J. JENNER
W. EDWARD BAILEY
DAVID J. LEE
PATRICIA A. MARTONE
JAMES F. HALEY, JR.
RICHARD M. BARNES
LAURENCE S. ROGERS
THOMAS L. GIANNETTI
VINCENT N. PALLADINO
ROBERT J. GOLDMAN
THOMAS L. SECREST
DANIEL M. GANTT

FREDERICK P. FISH
1855-1930
CHARLES NEAVE
1867-1937

NORMAN H. BEAMER
C. JOSEPH LAUGHON, II
RICHARD A. INZ
A. PETERADLER
THOMAS H. BECK
SUSAN PROGOFF
KEVIN J. CULLIGAN
GLENN A. OUSTERHOUT
MARGARET A. PIERRI
RON E. SHULMAN
DOUGLAS J. GILBERT
THOMAS J. VETTER
WAYNE M. KENNARD
LEON R. YANKWICH
DENISE LORING
JEFFREY H. INGERSMAN
ROBERT M. ISACKSON
RICHARD S. BULLITT
CHRISTOPHER B. GARVEY
ROBERT A. MORRIS
DAVID K. BARR
CHRISTA HILDEBRAND

LISA E. CRISTAL
EDWARD P. KELLY
ROBERT A. MUSICANT
MARK H. BLOOMBERG
JAMES T. CANFIELD
ALAN D. SMITH
KELLY L. MORRIS
DONNA M. DEGRANDI
ERIC M. LEE
JANE A. MASSARO
DUANE DAVID HOUGH
MITCHELL P. BROOK
JAMES W. BRADY, JR.
JOHN H. RUNNELS
JOHN F. WARD
DAVID J. MEYER
DOREEN F. SHULMAN
EDWARD J. DEFRANCO
MARK D. ROWLAND
TERRENCE J. P. KEARNEY
DAVID J. LARWOOD

RECEIVED
PHILIP MORRIS MANAGEMENT CORP.
LAW DEPT-PATENT SECTION

MAR 04 1988

NOTED DM/FJR

February 26, 1988

VIA AIR MAIL

Mr. P. Antony Smith
Reddie & Grose
16 Theobalds Road
London WC1X 8PL
ENGLAND

European Application No. 83308033.6
Your Ref. 26046
Our Ref. PM 653 EPO

Dear Antony:

I have reviewed your December 9, 1987 letter to Beverly Monroe and a copy of the first official action to issue in this application. Herewith are my comments, which are based in part on my discussions last year with one of the inventors (Mr. Keritsis) in connection with the corresponding Australian case.

Generally, the European Examiner's action in this case appears to be similar to the Australian Examiner's action in the corresponding case. Although we believe novelty exists over the references, we recommend responding as in the Australian case by (1) cancelling the article claims 13-19, and (2) arguing the validity of the method claims 1-12.*

* Consider adding to this application, if appropriate, a claim similar to pending claim 13 in the Australian case: "A method of making a foamed, tobacco-containing smoking article substantially as hereinbefore described with reference to any one of the examples."

2026536991

FISH & NEAVE

TO Mr. Smith

(2)
FOLIO

If, however, there is any reason why you think that such a response would be inappropriate under European practice, or if there are differences between the Australian and EPO cases that we should first consider, please let us know.

Regarding British Specification 1,055,445 (the "G.B. reference"), I agree with your assessment that the Examiner's reliance on that reference is misplaced. The G.B. reference does not show or suggest a method for making a "foamed, extruded, tobacco-containing article" and, as you noted, it does not teach or suggest that its "wet blend" may be extruded "under conditions of temperature and pressure such that some of the moisture is converted to steam, thereby foaming the article" as in claim 1.

The G.B. reference refers instead to a method for preparing a

"shaped smoking article in which it is unnecessary to foam the tobacco slurry and wherein, in lieu thereof, the matrix for the tobacco article is formed or shaped by surface adhesion of tobacco particles to produce an integrated porous network" (page 1, lines 45-54).

The Examiner's conclusion that the known extrusion techniques "cause the known effects of foaming the article" is incorrect. There is no showing or suggestion in the G.B. reference of foaming the shaped article by causing the moisture to evaporate during extrusion as in applicants' invention. Rather, the G.B. reference refers to forming -- not foaming -- shaped articles using known extrusion or molding techniques (see page 2, lines 60-64).

According to the G.B. reference, it is the heating process, which occurs after the article has been shaped, and not the extrusion process, that causes setting of the thermogelling adhesive and removal of water from the resultant matrix to yield the porous structure. The reference teaches that the porous structure is made with little distortion or blowing, and what little blowing of the material there is occurs only after the shaped slurry was gelled into the matrix. See page 3, lines 30-95, page 4, lines 68-74. Thus, the G.B. reference is antithetical to, and teaches away from, applicants' invention.

Furthermore, and contrary to the Examiner's assertion, by controlling the viscosity of the "wet blend" within the parameters set forth in the G.B. reference, one skilled in the

2026536992

FISH & NEAVE

TO Mr. Smith

(3)
FOLIO

art would not determine applicants' invention. Rather, they would learn to control the viscosity to shape the slurry, so that it can be "extruded or otherwise molded to form shaped articles using known extrusion or molding techniques" (page 2, lines 32-64) whereby the shaped article will "maintain its shape before and during the drying operation" (page 3, lines 12-15), as taught by the G.B. specification.

The hypothetical "optimization of the amounts of components" suggested by the Examiner would not produce, and would not suggest producing the foamed, extruded article, or methods for producing the same, of applicants' invention. There is no showing or suggestion in the G.B. reference of optimizing the viscosity parameters so that (1) the extruded material will be foamed as a result of the extrusion conditions of temperature and pressure, or (2) the selected amount of water in the slurry will convert to steam upon extrusion, thereby foaming the article. That is what applicants have discovered, and claimed.

If you think it necessary to discuss the Canadian patent in responding to the action, I refer you to my June 15, 1987 letter to you in the Australian case, which you can adapt to this case as appropriate.

Regarding the non-obvious features of this invention, the references relied on by the Examiner refer to forming sheets of material which must be rolled into a smoking article or cut up for use as tobacco filler for a smoking article, or forming tube segments which must pass through several processing stages, e.g., forming, setting and drying, before it can be used in a smoking article. Applicants' invention advances this known art in a novel manner. It avoids expensive and time consuming steps intermediary to forming the extruded material and using that material in an article. It also allows for using reduced amounts of binders, and provides better control over the extrudate by forming foamed smoking articles directly and continuously, using the wet blend extrusion process described and claimed. In addition, the present application allows for direct extrusion of the body of the cigarette in a condition suitable for direct use after application of the usual wrapper.

2026536993

FISH & NEAVE

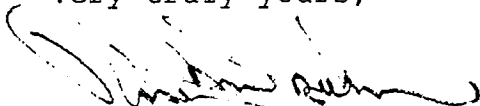
TO Mr. Smith

FOLIO (4)

Please do not hesitate to contact me if you have any further questions.

Best regards.

Very truly yours,



Robert M. Isackson

RMI/grl

cc: Arthur I. Palmer, Jr., Esq.

2026536994